

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Kyu Dong KIM, et al.

Application No.: 09/725,933

Confirmation No.: 2877

Filed: November 30, 2000

Docket No.: 0766.0002.US

Group Art Unit: 3623

Examiner: DESHPANDE, Kalyan K

For: **SYSTEM AND METHOD FOR AUTOMATING A PROCESS OF BUSINESS
DECISION AND WORKFLOW**

Mail Stop: Appeal Brief – Patents

Commissioner for Patents

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REPLY BRIEF

Sir:

This Reply Brief is in response to the Examiner's Answer mailed July 17, 2007. This is an appeal from the final rejection of all pending claims in this application, specifically, claims 1-17 and 19-43. If further fees are due upon filing of this Reply Brief, please charge such fees or credit any overpayment to **Deposit Account No. 50-3698 (H. C. Park & Associates, PLC)**.

In response to the Examiner's Answer mailed July 17, 2007 ("Examiner's Answer"), Appellants submit that the rejections of record are not proper and are without basis.

(i) STATUS OF CLAIMS

Claims 1-17 and 19-43 have been rejected and are being appealed.

Claim 18 has previously been canceled.

No claims have been allowed in this application.

(ii) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issue on appeal is whether claims 1-13, 19-20, 24, 26, and 28-31 are unpatentable under 35 U.S.C. §102(e) as anticipated by U. S. Patent No. 6,430,538, issued to Bacon, *et al.* ("Bacon"); whether claims 14, 16-17, 25, 27, and 32-43 are unpatentable under 35 U.S.C. §103(a) as obvious over Bacon; and whether claims 15 and 21-23 are unpatentable under 35 U.S.C. §103(a) as obvious over Bacon in view of U.S. Patent No. 5,999,911 issued to Berg, *et al.* ("Berg").

(iii) ARGUMENT

SUMMARY OF ARGUMENT

A *prima facie* case of anticipation has not been established to support a rejection of the claims under 35 U.S.C. §102. The examiner fails to show that a single prior art reference discloses each and every element of the claims under consideration.

Further, a *prima facie* case of obviousness has not been established to support a rejection of the claims under 35 U.S.C. §103. First, there is no reason to modify the cited references. Even if there were a reason to combine or modify the cited references and a reasonable expectation of success existed, the cited references fail to disclose every feature of the claimed invention. Therefore, the pending rejections should be withdrawn and the claims should be allowed to issue.

1. BACON FAILS TO DISCLOSE EVERY CLAIMED FEATURE OF CLAIM 1

Claim 1 recites a workflow management system for automating a business process, where an administrator executable by a computer manages automating the business process and comprises an organization manager, a role-group manager, an authority manager, a process manager, and a folder manager. Further, the system includes a form generator executable by the computer, where the form generator designs and operates an electronic form related to the business process, and interfaces with a database, a process designer, a process engine, a web client, and/or a business application program.

For a rejection under 35 U.S.C. §102 to stand, a single prior art reference must disclose each and every claim limitation under consideration. The Examiner must consider every claim limitation without dissecting the claimed invention into discrete elements and then evaluating the elements in isolation.

As explained in the Appeal Brief, Bacon fails to teach or suggest at least the aforementioned features. In the Examiner's Answer, the Examiner argues that "it is clear that a computer executes the administration activities even if the administration is controlled or prompted by a user."¹ However, claim 1 recites, "an administrator executable by the computer, wherein the administrator manages automating the business process and comprises an organization manager, a role-group manager, an authority manager, a process manager, and a folder manager." (*emphasis added*)²

The administration interface 140 of Bacon is not a user interface. The interface 140 merely represents a protocol between the server 110 and other component. Using that interface, a supervisor can add or remove a component to or from the system, such as another client or another database. A supervising person administratively maintains the server through the administrative interface. In other words, system design allows the maintenance or upgrading of the entire workflow management system through this administration interface 140. Therefore, contrary to the Examiner's mistaken interpretation, the administration interface 140 cannot anticipate claim 1.

Bacon mentions the administration interface 140 only once throughout the entire specification, saying "[A]dministration interface 140 allows a supervisor, i.e. a person, to manage the system as required."³ The Examiner mistakenly interpreted the supervisor as "end-user" or "participant". Also, the Examiner mistakenly confused the interface with "user interface" or graphical user interface. Bacon used the two different terms of "interface" and "user interface" in clear and very distinctive way. Bacon used the term of "interface" in the context of

¹ Examiner's Answer, page 32.

² Office Action, pages 2-3 and 7-8 (citing generally to Bacon, column 4, line 38 to column 5, line 14).

³ Bacon, column 5, lines 13-14.

system development. A clear example is "WORKFLOW CLIENT APPLICATION (INTERFACE 2) APPLICATION PROGRAMMING INTERFACE (WAPI) SPECIFICATION".⁴

On the other hand, Bacon distinctively used the term of user interface or graphical user interface (GUI) when the end-user or the participant of the work flow management uses the software.⁵ Therefore, the administration interface 140 is anything but a user interface. Rather, it is an application interface that may be used for future development or addition of other agent or client. Thus, it cannot be executable by computer.

Furthermore, even if the Examiner's interpretation is correct, *arguendo*, a person is not computer executable and does not comprise an organization manager, a role/group manager, an authority manager, a process manager, and/or a folder manager.

In the present application, the administrator of claim 1 is a software module that contains at least an organization manager, a role-group manager, an authority manager, a process manager, and a folder manager. In other words, the administrator of the present invention organically interacts with the managers it comprises to automate the workflow. This feature is materially distinguishable from the administration interface 140. Therefore, the administration interface 140 of Bacon does not teach or suggest the administrator of claim 1.

Bacon also fails to teach or suggest at least "a form generator executable by the computer, where the form generator designs and operates an electronic form related to the business process, and interfaces with a database, a process designer, a process engine, a web client, and/or a business application program," as explained in the Appeal Brief. The Examiner states that "the java applet can be called to generate a form that user requires (see Bacon

⁴ *Id.*, column 2, lines 6-9.

⁵ *Id.*, column 4, 24-28; column 5, lines 10-12; column 8, lines 25-26; column 9, lines 33-34; column 10, lines 58-59.

column 7, lines 1-3).⁶ However, the section of Bacon cited by the Examiner merely discusses that a participant's selection of an iconic representation of a work item in the client's task manager window causes a selection message to be sent to the server 110 indicating that a given work item has been selected.⁷ The form of the selection message is not disclosed by Bacon and there is no evidence that the selection message is an electronic form related to the business process, and interfaces with a database, a process designer, a process engine, a web client, and/or a business application program.

Additionally, while Bacon discloses the java applet 630 including logic for various application controls (column 7, lines 38-44), there is no disclosure of the java applet 630 generating a form.

The form generator of claim 1 actually generates a form that can be filled out by the user. Examples include, but are not limited to, an expense report form, a vacation request form, a business trip report form, a purchase request form, etc. The java applet of Bacon cannot generate these forms. Therefore, Bacon fails to teach or suggest that a form generator that designs and operates an electronic form related to the business process. Hence, Bacon fails to disclose every claim feature of claim 1.

Thus, the examiner has failed to establish a *prima facie* case of anticipation. Therefore, the rejection of claim 1, and all claims that depend therefrom, should be withdrawn.

**2. ONE OF ORDINARY SKILL IN THE ART WOULD HAVE NO REASON TO MODIFY
BACON TO ARRIVE AT THE PRESENT INVENTION**

⁶ Examiner's Answer, page 33.

⁷ Bacon, column 6, line 65 - column 7, line 4.

Claim 32 recites a method for automating a business process. The process includes steps for modeling the business process, where the step for modeling the business process further includes generating an organization chart; and executing the business process, where the step of executing the business process includes allocating the activity to a participant, and designing and creating an electronic form related to the business process.

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration.⁸ In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed.⁹ Thus, even if the prior art may be combined in the manner claimed, there must be a reasonable expectation of success, and the reference or references, when combined, must disclose or suggest all of the claim limitations.¹⁰

The Examiner states that "Bacon fails to teach: Modeling the business process, wherein the step of modeling includes generating an organization chart."¹¹ However, the Examiner fails to identify a reason that would have prompted a person of ordinary skill in the relevant art to include such a step. The Examiner refers to arguments made regarding claims 14, 16, and 17.¹² However, these claims address functions of the organization manager, the role/group manager, and the authority manager, respectively. As such, the Examiner's arguments with

⁸ *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

⁹ *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. ___, slip op. at 14-15 (2007).

¹⁰ *See in re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

¹¹ Office Action, page 20.

¹² See Examiner's Answer, pages 33-35.

regard to claims 14, 16, and 17 fail to address the deficiency in Bacon regarding generating an organization chart. Thus, absent any reason to modify Bacon, the Examiner has failed to demonstrate that Bacon renders the present invention obvious.

3. BACON FAILS TO TEACH OR SUGGEST ALL LIMITATIONS RECITED IN CLAIM 32

Last, a *prima facie* case of obviousness is not established where the combined or modified references fail to teach or suggest all limitations of the claimed invention. Because neither Bacon nor knowledge generally available to a person of ordinary skill in the art discloses all features of claim 32, the rejection thereof cannot stand.

Claim 32 recites a method for automating a business process. The process includes steps for executing the business process, where the step of executing the business process includes allocating the activity to a participant, and designing and creating an electronic form related to the business process. As set forth in the Appeal Brief, Bacon fails to disclose at least this limitation of claim 32.

The Examiner states that "the java applet can be called to generate a form that user requires (see Bacon column 7, lines 1-3)."¹³ However, the section of Bacon cited by the Examiner merely discusses that a participant's selection of an iconic representation of a work item in the client's task manager window causes a selection message to be sent to the server 110 indicating that a given work item has been selected.¹⁴ Therefore, Bacon fails to teach or suggest designing and creating an electronic form related to the business process. Hence, Bacon fails to disclose every claim feature of claim 32.

¹³ Examiner's Answer, page 33.

¹⁴ Bacon, column 6, line 65 - column 7, line 4.

CONCLUSION

With respect to claim 1, a *prima facie* case of anticipation has not been established because Bacon fails to teach or suggest each and every claim limitation under consideration. With respect to independent claim 32, a *prima facie* case of obviousness has not been established because there is no motivation to combine or modify the cited references. Even if there were motivation to combine or modify the cited references and a reasonable expectation of success, the cited references fail to disclose every feature of the claimed invention. Therefore, the pending rejections of claims 1-17 and 19-43 cannot be allowed to stand. Accordingly, claims 1-17 and 19-43 are in condition for allowance.

Respectfully Submitted,

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